UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,872	04/26/2001	Donal Doherty	1817-0109P	6150

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AKINTOLA, OLABODE

ART UNIT	PAPER NUMBER
3624	

DATE MAILED: 04/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 April 2001*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-38* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the

subject matter which the applicant regards as his invention.

Claims 1- 14, 17 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

In particular, claims 5, 7, 12 and 14 are unclear, ambiguous and incomprehensible. The claims

recite, "prior to transmitting acceptance of the order, the broker computer transmits *merchant*

computer acceptance.... to the customer". It is not clear what the merchant computer acceptance

is (page 15, line 8) and what acceptance is transmitted to the merchant (page 15, line 11).

Furthermore, in view of claims 4, 6, 11 and 13 respectively, the claims recite, " the merchant

transmits acceptance order ...... to the broker", a method step succeeding the steps of claims 5,

7, 12 and 14 as recited above, appear to be logically incorrect, making the claims

incomprehensible.

For examining purposes, the claims 5, 7, 12 and 14 would be given its broadest

interpretation and would be interpreted as "subsequent to transmitting acceptance of the order,

the broker computer transmits merchant computer acceptance.... to the customer" because the

broker computer could not have transmitted merchant computer acceptance of the order to the

customer computer without first receiving such acceptance from the merchant computer.

Claim 1 recites the limitation "the merchant computer" on page 13, line 17. There is

insufficient antecedent basis for this limitation in the claims. Particularly, line 16 on the same

page recites "each merchant computer", hence the "merchant computer" in line 17, should read

"merchant computers" and "a quotation" should read "quotations".

Claims 2-14, 17 and 36 recite the limitation "the merchant computer". There is

insufficient antecedent basis for this limitation in the claims.

Claims 2, 3, 4, 6, 9, 10, 11 and 13 recite the limitation "the relevant portion". There is

insufficient antecedent basis for this limitation in the claims.

Claims 4, 5, 6, 7,11, 12, 13 and 14 recite the limitation "the order". There is insufficient

antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
>
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
>
> requirements of this title.

Claims 17-38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-

statutory subject matter.

Functional descriptive material, per se, is not statutory. This is exemplified in In re Warmerdam

31 USPQ2d 1754 where the rejection of a claim to a disembodied data structure was affirmed.

Thus a claim to a data structure, per se, or other functional descriptive material, including

computer programs, per se, is not patent eligible subject matter.

Functional descriptive material claimed in combination with an appropriate computer readable

medium to enable the functionality to be realized is patent eligible subject matter if it is capable

of producing a useful, concrete and tangible result when used in the computer system. Compare

Warmerdam to In re Lowry 32 USPQ2d 1031 where a memory with a data structure that

increased computing efficiency was patentable.

The computer readable medium loaded with a computer program and in association with a

computer provides the functional descriptive material in usable form to permit the functionality

to be realized with the computer. A program product which does not explicitly include such a

medium, a program per se, a signal or other type of transmission media that fails to include the

hardware necessary to realize the functionality (e.g., a transmitter or a receiver), and a piece of

paper with the functional descriptive material written on it are all examples of media which are

not believed to enable the functionality to be realized with the computer.

Claims 18-22, 24, 26, 29-33, 35 and 37: recite computer program per se, which is not

patent eligible subject matter based upon the foregoing analysis.

Claims 17, 23, 25, 27, 28, 34, 36 and 38: the disclosed invention is inoperative and

therefore lacks utility.

In particular, claims 17, 23, 25, 27, 28, 34, 36 and 38 merely recite an apparatus (a

computer) without providing a structure of the apparatus ("means for" corresponds to software

program elements and not tangible hardware components of an apparatus) and therefore cannot

realize functionality of the recited elements (i.e. functional descriptive material per se) and

therefore is rendered inoperative lacking any utility.

Note that a computer (or software program) code cannot by itself perform the underlying

function until it is loaded on some computer readable memory and accessed by the computer (or

a processor).

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on

sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17-21, 25-26, 28-32, 36-37 are rejected under 35 U.S.C. 102(b) as being

anticipated by Mandler et al (U.S. Patent No. 5732400) hereinafter referred to as Mandler.

Re claim 17-21: Mandler teaches means for receiving an initial trading request from a

customer computer (Col. 4, lines 20-23); means for sending the initial trading request to one or

more merchant computers with a quotation request (Col. 4, lines 26-28); means for receiving

quotations from the merchant computer (Col. 4, lines 29-30); means for preparing a proposed

trading request from the quotations (Col. 4, lines 29-32); and means for downloading the

proposed trading request to the customer computer (Col. 4, lines 29-32). Note that record

medium, computer memory and read only memory are all inherent features in a computer

apparatus.

Re claims 25- 26 and 36-37: Mandler teaches means for receiving a transaction list from

a customer computer (col. 14, lines 9-14); and means for using the transaction list to complete

the transaction with the merchant computer for the customer computer (col. 15, lines 47-65).

Re claims 28-32: Mandler teaches means for downloading an initial trading request to the

broker computer with a quotation request (Col. 4, lines 20-23); means, on receiving the quotation

request as a proposed trading request from the broker computer, to prepare a transaction list (Col.

4, lines 29-32; col. 14, lines 9-14); means for sending the transaction list to the broker computer;

and means for completing the transaction (col. 14, lines 6-14; col. 15, lines 47-65). Note that

record medium, computer memory and read only memory are all inherent features in a computer

apparatus.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.

2.   Ascertaining the differences between the prior art and the claims at issue.

3.   Resolving the level of ordinary skill in the pertinent art.

4.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-16, 22-24, 27, 33-35 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mandler et al. (U.S. Patent No. 5732400) (hereinafter referred to as Mandler) in view of Hoffman (U.S. Patent Application No. 20010039529).

Re claims 1 and 8: Mandler teaches the steps of: the customer computer sending an initial trading request to the broker computer; the broker computer sending the initial trading request to each merchant computer with a quotation request; the merchant computer sending the quotation back to the broker computer; the broker computer preparing a proposed trading request from the quotations for the preferred merchants; and the broker computer downloading the proposed trading request to the customer (Col. 4, lines 20-42). Mandler does not explicitly teach the step of: the customer computer sending a list of preferred merchants to the broker computer. Hoffman teaches the step: of the customer computer sending a list of preferred merchants to the broker computer (section [0008][0034]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to modify Mandler to include the step wherein the customer computer sending a list of

preferred merchants to the broker computer as taught by Hoffman so that the customers can

establish the identity of merchants they wish to deal with, thereby saving time.

Re claims 3, 4, 6, 10, 11 and 13: Mandler and Hoffman are discussed above.

Furthermore, Mandler teaches the steps wherein the customer computer receives the proposed

trading request; the customer computer displays the proposed trading request; the customer

computer prepares a transaction list from the proposed trading request; the customer computer

sends the transaction list to the broker computer; and the broker computer transmits the relevant

portion of the transaction list to the merchant computer (Col. 4, lines 20-42); the merchant

computer transmits acceptance of the order, delivery details and a payment request to the broker

computer (col. 14, lines 52-57; col. 3, lines 58-65; col. 15, lines 47-65); the broker computer

confirms completion to the merchant computer (col. 15, lines 47-65); the broker computer

confirms payment with the customer computer; and the broker computer confirms payment to

the merchant computer (col. 3, lines 58-65; col. 4, lines 38-42).

Re claims 2 and 9: Mandler and Hoffman are discussed above. Furthermore, Mandler

teaches the step wherein the customer computer receives the proposed trading request; the

customer computer displays the proposed trading request; the customer computer prepares a

transaction list from the proposed trading request (col. 4, lines 20-42). Mandler did not explicitly

teach the step: the customer computer sends the relevant portion of the transaction list to the

merchant computer. Hoffman teaches the step: the customer computer sends the relevant portion

of the transaction list to the merchant computer (sections [0007][0008]). Therefore, it would

have been obvious to one of ordinary skill in the art at the time of the invention to modify

Mandler to include the step: the customer computer sends the relevant portion of the transaction

list to the merchant computer as taught by Hoffman rather than sending it through the broker as a

matter of design choice in the event that the broker computer breaks down.

Re claims 5, 7, 12 and 14: Mandler and Hoffman are discussed above. Furthermore,

Mandler teaches the step wherein <u>subsequent</u> to transmitting acceptance of the order, the broker

computer transmits merchant computer acceptance, delivery and payment details to the customer

computer and on receiving confirmation from the customer computer, transmits the acceptance

to the merchant computer (col. 4, lines 20-42; col. 14, lines 52-57; col. 3, lines 58-65; col. 15,

lines 47-65)

Re claim 15: Mandler and Hoffman are discussed above. Mandler and Hoffman do not

explicitly teach the step in which the preferred merchants are stored in order of customer

preference. Official notice is hereby taken that it is old and well known in the art to prioritize the

list of merchants according to customer preference. Therefore, it would have been obvious to one

of ordinary skill in the art at the time of the invention to modify Mandler in view of Hoffman to

include the step in which the preferred merchants are stored in order of customer preference

because it greatly improves the system by allowing the customer to prioritize the merchants

he/she wants to deal with.

Re claim 16: Mandler and Hoffman are discussed above. Furthermore, Mandler teaches

the step in which the broker computer prepares the proposed trading request having regard to

pre-established rules agreed with the customer (col. 3, lines 55-58).

Re claims 23, 24, 27, 34, 35 and 38: Mandler is discussed above. Mandler teaches means

for storing in a merchant database, a list of merchants for each customer; means for retrieving the

list of merchants on receiving the initial trading request; and means for sending the quotation

request to the merchant computers (col. 4, lines 20-42). Mandler does not explicitly teach

preferred merchants. Hoffman teaches preferred merchant (section [0008][0034]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to modify Mandler to include preferred merchants as taught by Hoffman so that the

customers can establish the merchant they wish to deal with, thereby saving time.

Re claim 22 and 33: Mandler and Hoffman are as discussed above. Furthermore,

Hoffman teaches electrical carrier signal (section [0006]). Therefore, it would have been obvious

to one of ordinary skill in the art at the time of the invention to modify Mandler to include

electrical carrier signal as taught by Hoffman because it allow the system to communicate

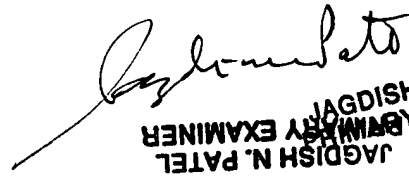wirelessly thereby improving the system.

Conclusion

5.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Olabode Akintola whose telephone number is 571-272-3629.

The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OA

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PRIMARY EXAMINER